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No. 938

# Supreme Court of the United States

OCTOBER TERM, 1946

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VULCAN CORPORATION,

*Petitioner,*

v.

INTERNATIONAL SHOE MACHINE CORPORATION, ET AL.,

*Respondents.*

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## PETITION FOR WRIT OF CERTIORARI AND BRIEF

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WALTER F. MURRAY,
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THE JOHNSON & HARDIN CO., LAW PRINTERS
CINCINNATI, OHIO

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## PETITION FOR WRIT OF CERTIORARI

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May it please the Court:

The petition of the Vulcan Corporation respectfully shows to this Honorable Court:

I. That petitioner is the owner of United States Letters Patent No. 2,065,655 for a shoe last;

II. That petitioner on October 15, 1945 filed suit against respondents for infringement of the patent, in the District Court of the United States for the District of Massachusetts;

III. That before any testimony had been taken, defendants filed a motion for summary judgment under Rule 56, stating that the construction and operation of the shoe last charged to be an infringement had been agreed upon by stipulation of the parties, that there was no genuine issue as to any material fact relating to the alleged infringement, and that in support of the motion defendants would rely upon the complaint, upon the patent, and upon the stipulation (Rec. pp. 11 and 12).

IV. That on January 31, 1946 the District Judge granted respondents' motion for summary judgment on the ground of non-infringement (Rec. p. 13);

V. That on December 9, 1946 the Circuit Court of Appeals of the First Circuit affirmed the judgment upon the opinion of the District Court;

VI. That upon December 26, 1946 the Circuit Court of Appeals of the First Circuit denied petitioner's petition for rehearing, without opinion.

## REASONS ADVANCED FOR ALLOWING THE WRIT

There has been so much difference in the grounds upon which the United States Circuit Courts of Appeals of the several Circuits have sustained motions for summary judgments, that the proceeding is in a state of uncertainty and there is need for this Honorable Court to establish a rule to be followed by these courts in granting such motions for summary judgments.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court, directed to the United States Circuit Court of Appeals of the First Circuit commanding that Court to certify and to send to this Court for its review and determination, on a day certain to be therein named, a full and complete transcript of the record and all proceedings in this case that is numbered 4179, and entitled *Vulcan Corporation, Plaintiff, Appellant,* v. *International Shoe Machine Corporation, et al., Defendants, Appellees,* and that said judgment of the Circuit Court of Appeals of the First Circuit be reversed by this Honorable Court.

VULCAN CORPORATION.
By WALTER F. MURRAY,
L. G. MILLER,
*Counsel for Petitioner.*

# Supreme Court of the United States

VULCAN CORPORATION,

*Petitioner,*

v.

INTERNATIONAL SHOE MACHINE CORPORATION, ET AL.,

*Respondents.*

## BRIEF

The Court's attention is respectfully directed to some of the decisions of the United States Courts of Appeals of several Circuits to show the differences in the grounds that they give for their actions on motions for summary judgments.

The COURT OF APPEALS OF THE SECOND CIRCUIT has taken the following actions on motions for summary judgment, viz:

In *Arnstein* v. *Porter,* 154 Fed. (2d) 464-468 they said:

> "The principal question on this appeal is whether the lower court, under Rule 56, properly deprived plaintiff of a trial of his copyright infringement action. The answer depends on whether 'there is the slightest doubt as to the facts.' "

In *McElwain* v. *Wickwire Spencer Steel Co.,* 126 Fed. (2d) 210-211, they said:

> "Where there is a substantial dispute as to a material fact it cannot be said that the only issue is one of 'law'. . . ."

In *Doehler Metal Furniture Co., Inc.* v. *United States,* 149 Fed. (2d) 130-135, they said:

> "We take this occasion to suggest that trial judges should exercise great care in granting motions for summary judgment. A litigant has a right to a trial where there is the slightest doubt as to the facts. . . ."

In *Weisser* v. *Mursam Shoe Corporation,* 127 Fed. (2d) 344-346, they said:

> "The defendants explain or deny many of the facts relied upon by the plaintiffs, but since this case comes up on motion for summary judgment, we must give the plaintiffs the benefit of every doubt."

In *Cohen* v. *Eleven West 42nd Street, Inc.,* 115 Fed. (2d) 531-532, they said on p. 532:

> "A motion for summary judgment is not a trial; on the contrary it assumes that scrutiny of the facts will disclose that the 'issues presented by the pleadings' need not be tried because they are so patently insubstantial as not to be genuine issues at all. Consequently, as soon as it appears upon such a motion that there is really something to 'try,' the judge must at once deny it and let the cause take its course in the usual way. . . ."

In *Parmelee* v. *Chicago Eye Shield Co.,* 157 Fed. (2d) 582-585, the COURT OF APPEALS OF THE EIGHTH CIRCUIT said at p. 585:

> ". . . Rule 56 is designed for the prompt disposition of the action where there is no genuine issue regard-

> ing any material facts, thus avoiding a useless trial to prove facts which are not really disputed. *Altman* v. *Curtiss-Wright Corp.*, 2 Cir., 124 F. (2d) 177; *Miller* v. *Miller*, 74 App. D. C. 216, 122 F. (2d) 209. The rule contemplates an inquiry in advance of trial as to whether there is a genuine issue and may be invoked for the purpose of striking sham claims and defenses which obstruct a prompt determination of the truth. It can not be so applied as to deprive a litigant of his right to try any genuine issue by jury or otherwise."

In *Whitaker* v. *Coleman*, 115 Fed. (2d) 305-306, the COURT OF APPEALS OF THE FIFTH CIRCUIT said:

> ". . . To proceed to summary judgment it is not sufficient then that the judge may not credit testimony proffered on a tendered issue. It must appear that there is no substantial evidence on it, that is, either that the tendered evidence is in its nature too incredible to be accepted by reasonable minds, or that conceding its truth, it is without legal probative force."

In *Toebelman* v. *Missouri-Kansas Pipe Line Co.*, 130 Fed. (2d) 1016-1018, the COURT OF APPEALS OF THE THIRD CIRCUIT said:

> ". . . Upon a motion for a summary judgment it is no part of the court's function to decide issues of fact but solely to determine whether there is an issue of fact to be tried."

In the instant case the COURT OF APPEALS OF THE FIRST CIRCUIT adopted the District Judge's opinion which said:

> "Since the accused structure does not contain all the elements of claim 1 (that is, it does not include the toggle and stop) or their equivalents, the accused last is not, and could not be shown by any evidence to be an infringement."

It is submitted that the differences between the rulings of the Circuit Courts of Appeals of the Second Circuit, of the Third Circuit, of the Fifth Circuit and of the Eighth Circuit on one hand, and that of the First Circuit on the other hand, are so vital to the public, that this Honorable Court should declare what is the present law on the subject of Summary Judgments.

## DEFENDANTS' MOTION

The District Court Judge based his decision of the motion for summary judgment upon definitions of a toggle, which he found in Knights American Mechanical Dictionary and in a decision by the United States Circuit Court of Appeals of the Sixth Circuit in a case that did not relate to the patent here in suit. He ended his quotations of the definitions of a "toggle" with these words: "Its usual office is to translate lateral into longitudinal motion" (Rec. p. 14). He ended his description of defendants' last, with these words: "From the description it is plain that defendants' last does not use a toggle or any other mechanical means for forcing apart the heel and forepart portions of the last. The two sections are extended by hand or other means wholly independent of the last itself" (Rec. p. 15). The District Judge failed to see that in the preferred use of the patented last a toggle was not used for forcing apart the heel and forepart portions of the last and that the two sections of the patented last were extended by lever 9 which also is wholly independent of the last (Rec. p. 7, column 2, lines 24-28). He failed to compare the function which the latch member performed in defendants' last with the function that the toggle performed in the patented last. His decision was based upon the names of the parts and not upon their functions. His action conflicts with the decision of this Honorable Court in *Machine Co.* v. *Murphy,*

97 U. S. 120, 125, viz: "... in determining the question of infringement, the court or jury, as the case may be, are not to judge about similarities or differences by the names of things, but are to look at the machines or their several devices or elements in the light of what they do, or what office or function they perform, and how they perform it, and to find that one thing is substantially the same as another, if it performs substantially the same function in substantially the same way to obtain the same result."

That the functions which are performed by the "toggle means" in the patented last, and by the "latch means" in the infringing last are substantially the same is shown by the following comparison of the lasts.

The patented last comprises a heel part 1 and a toe or forepart 2, having opposite flat faces 3 and 4, and longitudinal guide rods 5 and 6 for guiding the fore and heel parts along a straight line path and to maintain the parts in proper alinement throughout the expansion and contraction of the last (Line 55, column 1 and lines 1-23, column 2, Rec. p. 7).

The expansion of the last may be accomplished by the insertion of a tool 9 between the heel and toe parts and using the tool as a lever to force the parts into their expanded position (Lines 24-28, column 2, Rec. p. 7).

The preferred use of the patented last is described in lines 13 through 26, column 1, Page 2 of the specification (Rec. p. 8) thus:

> "The vamp and quarter are sewed or otherwise secured in the usual manner to form the upper structure of the shoe. The upper is then sewed directly to the inner sole. At this time the shoe's upper is in a mulled or softened condition and is ready for the final lasting operation. Up to this point, the assembling operations are executed more readily without the use of the last. To continue the construction of the shoe the last is

> inserted therein while in its contracted condition, a suitable lever is then inserted between the last parts which are then forced apart by means of the lever into their expanded position. . . ."

The description of defendants' last is given in plaintiff's Exhibit 2 (Rec. p. 12). Defendants' last comprises a heel portion 1 and a fore portion 2 which are provided with horizontal bores 8 and 9, and 15 and 16 which aline with the bores 8 and 9 when the last parts are assembled. Rods 10 and 11 guide the relative movements of the heel and fore parts in a straight line extending longitudinally of the last. Between the fore part and the heel part of defendants' last there is a latch member 23. The cooperation of the fore part and the heel portion of the last and the latch member is thus described in plaintiff's Exhibit 2:

> "When the forepart and heel portions of the last are moved apart, the latch member 23 slides along the upper surface of the guide rod 10 until it drops into the notch 17. This limits expansion of the last and holds the forepart and heel portions rigidly in the extended position" (Rec. pp. 17 and 18).

When the fore part and the heel part of the patented last, and of defendants' last are held in their extended positions, they have the contour that is to be given to the upper of the shoe.

It is submitted that the question as to whether or not the latch mechanism in defendants' last is the equivalent of the toggle mechanism in plaintiff's last, is a real issue, and that therefore the Court erred in granting defendants' Motion for Summary Judgment.

## CONCLUSION

It is respectfully submitted that this case is one that calls for the exercise by this Court of its supervisory power in

order that the present law on summary judgments, may be stated authoritatively.

Respectfully,

WALTER F. MURRAY,
L. G. MILLER,
*Counsel for Petitioner.*

FILE COPY

In the

# Supreme Court of the United States

OCTOBER TERM, 1948

No. 68

VULCAN CORPORATION,

*Petitioner,*

v.

INTERNATIONAL SHOE MACHINERY CORPORATION ET AL.,

*Respondents.*

## BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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In the

# Supreme Court of the United States.

OCTOBER TERM, 1946.

No. 938.

VULCAN CORPORATION, PETITIONER,

*v.*

INTERNATIONAL SHOE MACHINE CORPORATION ET AL., RESPONDENTS.

## BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

The petition and brief in support thereof, do not show that this case comes within the provisions Sect. 5(b) of Rule 38, of this Court.

This case does not present a situation wherein one Circuit Court of Appeals has rendered a decision in conflict with another Circuit Court of Appeals on the same matter; it does not present a question upon which varying views have been expressed by different Circuit Courts of Appeals; it does not present any unsettled legal proposition; nor does it present any question of general or public interest.

Instead, this is an ordinary patent case involving the usual issue of infringement, disposed of by summary judgment under Rules 12(c) and 56 of the Rules of Civil Procedure. The patent in suit has never previously been litigated.

## THE ISSUE.

The only reason advanced for granting the petition (Petition, page 2) is that because of an alleged "difference in the grounds upon which the United States Circuit Courts of Appeals of the several Circuits have sustained motions for summary judgments" there is a need to establish a rule to be followed by these Courts in granting motions for summary judgments.

Ostensibly the petition is a request for a ruling as to the law of summary judgments. In reality it is only an effort to have this Court rule as to whether the accused device infringes the patent in suit.

## PETITIONER'S CASE.

In support of its allegation of a difference in the practice of the various Circuit Courts of Appeals in respect to motions for summary judgment, Petitioner cites decisions (with quotations) from the Second, Third, Fifth and Eighth Circuits.

Not one of the cited decisions from the above Circuits concerns a patent or a patent infringement matter. *Arnstein* v. *Porter,* 154 F. (2d) 464, 468, is a copyright infringement case; *McElwain* v. *Wickwire Spencer Steel Co.,* 126 F. (2d) 210, 211, is a case under the Workmen's Compensation Law; *Doehler Metal Furniture Co., Inc.* v. *United States,* 149 F. (2d) 130, 135, is a suit on a contract for sale; *Weisser* v. *Mursam Shoe Corporation,* 127 F. (2d) 344, 346, is an action for recovery of rent; *Cohen* v. *Eleven West 42nd Street, Inc.,* 115 F. (2d) 531, 532, is a bankruptcy case; *Parmelee* v. *Chicago Eye Shield Co.,* 157 F. (2d) 582, 585, is an action on an account for goods sold and delivered; *Whitaker* v. *Coleman,* 115 F. (2d) 305, 306, is an action for damages for accidental death; *Toebelman* v. *Missouri-Kansas Pipe Line Co.,* 130 F. (2d) 1016, 1018, is a stockholder's derivative suit.

All of the above cases *agree* that summary judgment is

applicable where there is no genuine issue as to any material *fact.*

Petitioner then quotes from the decision of the District Court in the instant case in support of its argument that the District Court and the Court of Appeals for the First Circuit, in the case at Bar, did not follow the general practice as to summary judgments. The quotation is as follows:

> "Since the accused structure does not contain all the elements of claim 1 (that is, it does not include the toggle and stop) or their equivalents, the accused last is not, and could not be shown by any evidence to be an infringement."

The most that can be made from the above quotation is that the District Court was confident that there was no genuine issue as to any material fact and that the moving party was entitled to a judgment as a matter of law (Rule 56).

Petitioner fails utterly to show that the Courts of the First Circuit disagree with or fail to recognize or to follow the general practice which is in conformity with the express language of Rule 56. In particular, Petitioner has completely failed to point to any genuine issue as to any material fact.

## RULE 56 IS APPLICABLE IN PATENT INFRINGEMENT CASES.

The notes of the Advisory Committee appended to Rule 56 of the Rules of Civil Procedure state:

> "This rule is applicable to all actions, including those against the United States or an officer or agency thereof.
>
> "Summary judgment procedure is a method for promptly disposing of actions in which there is no genuine issue as to any material fact."

Rule 56 does not specifically except patent cases from its application and the Courts have consistently recognized the rule as applicable to patent infringement cases. Among others is *Milcor Steel Company* v. *George A. Fuller Company,* 122 F. (2d) 292, which came up to this Court on certiorari and is reported at 316 U. S. 143. While the specific question of the applicability of a motion for summary judgment to a patent infringement case was not passed upon by this Court, the Court remarked, without comment, that the District Court had entered summary judgment for the Defendants and that the District Court had been affirmed by the Circuit Court of Appeals. The Supreme Court affirmed the judgment of the District Court which dismissed the case for invalidity of the patent claims.

## THERE IS NO GENUINE ISSUE AS TO ANY MATERIAL FACT.

In the instant case the accused device (Ex. No. 1) in physical form was before the District Court by stipulation (R. p. 10); an agreed statement (Ex. No. 2) of its structure and mode of operation was before the District Court by stipulation (R. p. 10); and the file wrapper and contents of the patent in suit was before the Circuit Court of Appeals by stipulation as a physical exhibit (R. p. 23). The subject matter is of a simple nature, easily understood by anyone.

Petitioner did not, in its brief before the Circuit Court of Appeals, nor does it in its petition to this Court, point to any disputed issue of *fact* or aver that any material fact was unknown to the District Court but only suggests that the District Court erred in ruling, upon the agreed facts, that the accused last was not the equivalent of the claimed structure. At page 8 of the petition, Petitioner tacitly admits that the question of equivalency is the real issue.

Equivalency, under the conditions here present, is a question of law, not fact, hence this case was properly disposed of by summary judgment in applying the law of equivalency to the agreed facts.

In *Sanitary Refrigerator Company* v. *Winters,* 280 U.S. 30, 36, in considering the question of patent infringement this Court remarked:

> "Furthermore, upon the undisputed evidence the question of infringement resolves itself in each case into one of law, depending upon a comparison between the structure disclosed on the face of the patent and the device shown in the Dent latch, and the correct application thereto of the rule of equivalency. Compare *Singer Company* v. *Cramer,* 192 U.S. 265, 275."

*Singer* v. *Cramer,* referred to in the foregoing quotation, was also a patent infringement case. In that case this Court remarked:

> "As in each of the patents in question it is apparent from the face of the instrument that extrinsic evidence is not needed to explain terms of art therein, or to apply the descriptions to the subject matter, as we are able from mere comparison to comprehend what are the inventions described in each patent and from such comparison to determine whether or not the Diehl device is an infringement upon that of Cramer, the question of infringement or no infringement is one of law and susceptible of determination on this writ of error. *Heald* v. *Rice,* 104 U.S. 737; *Market Street Cable Ry. Co.* v. *Rowley,* 155 U.S. 621, 625."

In *United States* v. *Esnault-Pelterie,* 303 U.S. 26, 30 (a patent infringement suit brought in the Court of Claims), the Supreme Court remarked:

> "We are not unmindful of the rule that where, with all the evidence before it, it appears that no substantial dispute of fact is presented, and that the case may be determined by a mere comparison of structures and extrinsic evidence is not needed for purposes of explanation, or evaluation of prior art, or to resolve questions

of application of descriptions to subject matter, the questions of invention and infringement may be determined as questions of law." Citing *Heald* v. *Rice, supra; Singer Manufacturing Company* v. *Cramer, supra;* and *Sanitary Refrigerator Company* v. *Winters, supra.*

## CONCLUSION.

A large part of Petitioner's brief is devoted to argument, as to whether, under the facts of the case at bar, the accused device actually is the (patentable) equivalent of that claimed in the patent in suit. It would seem that this portion of Petitioner's brief is wholly irrelevant as respects the single reason advanced by Petitioner in support of its petition (Petition, p. 2). The petition really seeks to have this Court rule upon the question of infringement in the case at bar. The authorities cited by Petitioner are *inapt* and there is no substance to Petitioner's request.

It is respectfully submitted that the petition fails to suggest any proper ground for the exercise by this Honorable Court of its supervisory authority; in particular that it fails to show any conflict of opinion among the several Circuit Courts as to "the present law on Summary Judgments" or any error by the Circuit Court of Appeals for the First Circuit in respect to summary judgment procedure.

We submit that the Petition should be denied.

Respectfully,

HERMAN T. GAMMONS,
ROBERT L. THOMPSON,
*Counsel for Respondents.*

February, 1947.